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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,463	10/15/2001	William C. Johnson JR.	GEO-55	3692

7590 06/19/2007
Milton Wolson
11 Martine Avenue
12th Floor
White Plains, NY 10606

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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06/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/977,463

Applicant(s)

JOHNSON, WILLIAM C.

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 12 is finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claim 12, the limitations that "a water-impermeable, water-vapor permeable membrane extending below the thinner layer of cold insulation material" has no support in the specification because the bootie 8 can be waterproof without being water-impermeable.

Contrary to applicant's argument, the phrase "A waterproof bootie 8, formed for example, of material sold by W. L. Gore under the "Gore-Tex" trademark includes a relatively thin quilted layer 10 of cold insulating material above the toe region of the bootie 8" in the instant specification does not necessarily imply a water-impermeable, water-vapor permeable membrane.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claim 10 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Techboot WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419). WO'372 discloses all the limitations substantially as claimed including the following: a boot (see Figure 2); an outer layer 35 of stretchable leather (leather in and of itself is stretchable); an oversized toe box 27 supported on the outsole (see Figures 1-4, shows the toe box resting on the outsole) and covered by the layer of stretchable leather 35; the toe box being sized to enclose a substantial thickness of compressible cold insulation material **(foam layer 43 and the amount of dead air space in the foam layer 43)** and the corresponding portion of the user's foot without compression of the cold insulating material when the boot is worn (see page 5, lines 1-10, the toe cap is spaced "relatively high of the foot at the rear " to allow for flexibility of the foot and prevent rubbing of the toe cap against the top of the user's foot); a layer of compressible cold insulating material in its uncompressed state (a layer of compressible cold insulating material 43 secured to the inside of the toe box in an uncompressed state); a lining 34 having a first side facing the opposing surface of a portion of a user's foot (lowermost side of the insulating material); the lining extending below the opposing surface of the cold insulating material (lining attached to the sole and not compressing the insulating layer to the protector); an outsole 10. WO '372 does not disclose the insulating material being located but not being compressed between the toe box and a lining of the cold insulating material having a surface secured to the underside of the toe box. White '419 teaches that an insulating layer 5 for a toe protected boot can be located, uncompressed, between the toe box 1 and the lining 6 to provide air absorption and

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cushioning to the user's foot during use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to place an insulating layer between the toe box and the liner of WO '372, as taught by White '419, to aid in protecting and cushioning the user's foot while insulating the boot as well. White '419 further discloses a toe cap 1 with a layer of cushioning material 5 attached to the under side of the toe cap by an adhesive 3 attaching the under side of the toe cap surface of the cushioning material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to attach the cushioning material to the toe cap by adhesive, as taught by White '419, to prevent the cushioning material from moving during flexing of the shoe during use.

With respect to claims 8 and 9, since the toe boxes of the references as applied above are intended to cover different size shoes, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to vary the size of the toe box to fit the size of the shoe being used, including a height of 1.9 inches and a length of 2 inches, so that the foot within the shoe is properly protected.

5. Claim 11 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419) as applied to claim 10 above, and further in view of Hill (US patent no. 2,814,888). The references as applied to claim 10 disclose all the limitations of the claims except for the thinner layer of cold insulating material extending below the second side of the lining. Hill '888 teaches that a pad 16 can be located under the lining and above another lining layer to add to cushioning of the toecap with respect to the user's toes. The pad would be

another lining layer that would retard cold air from getting to the user's foot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to add as many layers on insulating material under the toe cap, of the references as applied to claim 10 above as taught by Hill '888, to give the desired comfort of the user.

6. Claims 12 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419) and Hill (US patent no. 2,814,888) as applied to claims 10 and 11 above, and further in view of Aumann (US patent no. 5,689,903). The references as applied to claims 10 and 11 disclose all the limitations of the claims except for a layer of water-impermeable, water-vapor permeable membrane extending below the layer of cold insulating material. Aumann '903 teaches that it is desirable to have a layer of water-impermeable, water-vapor permeable, waterproof material L (see col. 2, lines 32-37) located adjacent the user's foot in the toe area of the shoe to allow water vapor from the perspiration of the user's foot to escape without allowing water (i.e. waterproofing) to enter the shoe through the material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to place a water-impermeable, water-vapor permeable material next to the user's foot for the boot of the references as applied to claims 10 and 11 above, as taught by Aumann '903 to allow for the user's foot to breath without building up perspiration.

Response to Arguments

7. Applicant's arguments filed April 23, 2007 have been fully considered but they are not persuasive. In response to applicant's argument that the foam layer of the instant application provides a cold insulating function, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

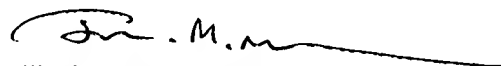
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
June 11, 2007